

Remarks

The Office Action mailed May 14, 2003, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-25 are now pending in this application. Claims 1-8 stand rejected. Claims 9-25 have been withdrawn from consideration.

In accordance with 37 C.F.R. 1.136(a), a three month extension of time is submitted herewith to extend the due date of the response to the Office Action dated May 14, 2003, for the above-identified patent application from August 14, 2003, through and including November 14, 2003. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$950.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-8 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Applicants have amended Claim 1 to overcome the § 112 rejection. Accordingly, Applicants respectfully request that the rejection of Claims 1-8 under Section 112, second paragraph, be withdrawn.

The rejection of Claims 1 and 3-4 under 35 U.S.C. § 102(b) as being anticipated by Biggs et al. (U.S. 3,986,380) is respectfully traversed.

Biggs describes a method for removing electrical runout in a machine shaft (see Abstract).

Notably, Biggs does not describe nor suggest a method for separating electrical runout from mechanical runout comprising pre-determining tolerances of mechanical runout; positioning at least one position probe such that the at least one position probe measures a position of a rotating part; positioning at least one proximity probe adjacent the rotating part; calculating an electrical runout based on measurements obtained from the at least one position probe and the at least one proximity probe; calculating the mechanical runout based on the at least one position probe; calculating a predicted slow roll test value; and comparing the predicted slow roll test value with the calculated mechanical runout, wherein a predicted slow roll test value of failure and a calculated mechanical runout value exceeding the pre-

determined mechanical runout value is indicative of the predicted slow roll test value of failure being caused by the mechanical runout.

Claim 1 recites a method for separating electrical runout from mechanical runout comprising pre-determining tolerances of mechanical runout; positioning at least one position probe such that the at least one position probe measures a position of a rotating part; positioning at least one proximity probe adjacent the rotating part; calculating an electrical runout based on measurements obtained from the at least one position probe and the at least one proximity probe; calculating the mechanical runout based on the at least one position probe; calculating a predicted slow roll test value; and comparing the predicted slow roll test value with the calculated mechanical runout, wherein a predicted slow roll test value of failure and a calculated mechanical runout value exceeding the pre-determined mechanical runout value is indicative of the predicted slow roll test value of failure being caused by the mechanical runout.

Biggs does not describe nor suggest the method recited in Claim 1. Specifically, Biggs does not describe nor suggest a method for separating electrical runout from mechanical runout comprising pre-determining tolerances of mechanical runout; positioning at least one position probe such that the at least one position probe measures a position of a rotating part; calculating the mechanical runout based on the at least one position probe; calculating a predicted slow roll test value; and comparing the predicted slow roll test value with the calculated mechanical runout, wherein a predicted slow roll test value of failure and a calculated mechanical runout value exceeding the pre-determined mechanical runout value is indicative of the predicted slow roll test value of failure being caused by the mechanical runout. Rather Biggs describes a method for removing electrical runout in a machine shaft. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Biggs.

Claims 3-4 depend directly from independent Claim 1 which is submitted to be in condition for allowance. When the recitations of Claims 3-4 are considered in combination with the recitations of Claim 1, Applicants respectfully submit that dependent Claims 3-4 are also patentable over Biggs.

For at least the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1 and 3-4 be withdrawn.

The rejection of Claims 2 and 5-8 under 35 U.S.C. § 103(a) as being unpatentable over Biggs (U.S. Patent No. 3,986,380) in view of Rozelle et al. (U.S. Patent No. 5,033,305) ("Rozelle") is respectfully traversed.

Biggs is described above. Rozelle describes a method for monitoring the movement of a rotating part of a machine.

Claims 2 and 5-8 depend from independent Claim 1. Claim 1 is recited hereinabove.

Neither Biggs or Rozelle, considered alone or in combination, describe or suggest the method as recited in Claim 1. More specifically, neither Biggs or Rozelle, considered alone or in combination, describe or suggest a method for separating electrical runout from mechanical runout comprising pre-determining tolerances of mechanical runout; positioning at least one position probe such that the at least one position probe measures a position of a rotating part; calculating the mechanical runout based on the at least one position probe; calculating a predicted slow roll test value; and comparing the predicted slow roll test value with the calculated mechanical runout, wherein a predicted slow roll test value of failure and a calculated mechanical runout value exceeding the pre-determined mechanical runout value is indicative of the predicted slow roll test value of failure being caused by the mechanical runout.

Rather, in contrast to the present invention, Biggs describes a method for removing electrical runout in a machine shaft; and Rozelle describes a method for monitoring the movement of a rotating part of a machine. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Biggs in view of Rozelle.

When the recitations of Claims 2 and 5-8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2 and 5-8 are also patentable over Biggs in view of Rozelle.

For at least the reasons set forth above, Applicants respectfully submit that the Section 103 rejection of Claims 2 and 5-8 be withdrawn.

In addition to the arguments set forth above, Applicants also respectfully submit that the Section 103 rejections of the presently pending claims are not proper rejections. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Biggs using the teachings of Rozelle. More

specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combinations. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

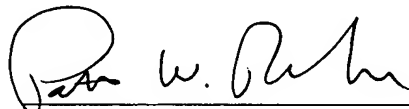
Neither Biggs nor Rozelle, considered alone or in combination, describe or suggest the claimed combination. Rather, the Section 103 rejection of Claims 2 and 5-8 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Biggs teaches a method for removing electrical runout in a machine shaft; and Rozelle describes a method for monitoring the movement of a rotating part of a machine. Since there is no teaching nor suggestion for the combination of Biggs and Rozelle, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 2 and 5-8 be withdrawn.

Additionally, none of Biggs or Rozelle, considered alone or in combination, describe or suggest the claimed combination. Rather, the Section 103 rejection of Claims 2 and 5-8 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Biggs teaches a method for removing electrical runout in a machine shaft; and Rozelle a method for monitoring the movement of a

rotating part of a machine. Since there is no teaching nor suggestion for the combination of Biggs and Rozelle, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicants request that the Section 103 rejection of Claims 2 and 5-8 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Patrick W. Rasche", written over a horizontal line.

Patrick W. Rasche
Registration No. 37,916
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070